

Remarks

The Office Action mailed August 21, 2006 has been carefully reviewed and the following remarks are made in consequence thereof.

The Commissioner is asked to consider this a petition for a one-month extension of time to and including December 6, 2006, to file this Response and is hereby authorized to charge deposit account number 01-2384 for the one-month extension of time set forth in 37 CFR 1.17(a)(1) of \$120.00.

Claims 1-15 and 19-30 are now pending in this application. It is respectfully submitted that the pending claims define allowable subject matter.

1. Preliminary Remarks In Response to Paragraph 2 of the Office Action

In paragraph 2 of the Office Action, it is stated that to the extent that Applicants consider the springs of Figure 4 of the parent application to collectively define the resistance mechanism recited in claim 1, the previous rejection of claim 1 based upon the Marks reference is withdrawn. However, the Office Action also states in paragraph 2 that to the extent that the resistance mechanism is intended to read on a spring extending through the handle of Figure 4 of the current application the previous rejection based on Marks is maintained because Applicants failed to show where there is clear support in the parent application for such an arrangement.

Preliminarily, Applicants note that claim 1 nowhere recites a spring at all, and claim 1 is not expressly limited to either of the embodiments noted in paragraph 2 of the Office Action. Indeed, claim 1 is intended to read on all embodiments disclosed.

Applicants also note that the present application incorporates by reference the entire disclosure of the parent provisional application, and as such the present application encompasses all the figures of the parent application. It is well settled law that the priority date of the parent application is retained for all common subject matter disclosed in the parent application and the present application. The recitations of claim 1 are respectfully submitted to encompass such common subject matter disclosed in the parent case and later claimed in the present application.

Alternatively stated, claim 1 is submitted to encompass both the embodiment of Figure 4 in the parent application *and* the embodiment depicted in Figure 4 of the present application because they are alternative embodiments of the same concept.

The assertion that there is no clear support in the parent application for the mechanism recited in claim 1 is submitted to be in error, as the specification of the parent application discloses multiple embodiments each of which fully support and clearly meet the recitations of claim 1. The fact that the present application discloses still other embodiments that also support and meet the recitations of claim 1 is submitted to be immaterial, and there is no basis for treating claim 1 differently on the ground that it is directed to one embodiment or the other.

Because the parent application clearly discloses embodiments that meet the recitations of claim 1, and also because the present application discloses embodiments that meet the recitation of claim 1, claim 1 is entitled to the priority date of the parent application that predates the publication date of the Marks reference. Marks '360 therefore does not qualify, vis-à-vis the present application, as prior art under any paragraph of § 102 and cannot be used to reject the present claims.

2. The Present Rejections

The prior art rejections will now be considered in the order set forth in the Office Action.

A. Pease in view of Westman

The rejection of claims 1-6, 9-11, 15, 19-23 and 25-30 under 35 U.S.C. § 103(a) as being unpatentable over Pease (U.S. Patent No. 6,431,418) in view of Westman (2,937,016) is respectfully traversed.

The inventions recited in the independent claims are not believed to be obvious over Pease in view of Westman. While Pease does disclose a weight measuring device at col. 18, lines 47-64, Pease fails to describe any actual implementation of the device in all its operating detail, including things such as how the devices would actually be connected to a case and how the devices would actually function to indicate a weight of the bag. Pease is therefore considered

to be silent regarding key aspects of the invention as claimed. For example, Pease mentions strain gauges, but fails to explain where they would be attached or how they would actually determine the weight of the bag. Pease also mentions a calibrated spring system, but fails to describe a single embodiment of a spring system in working detail. Presumably, Pease, by mentioning such devices only in passing and without any detailed explanation, intended to refer to known or conventional weighing devices and mechanisms. Applicants note that references disclosing conventional strain gauges and spring scales have previously been cited against the present claims and have proven to be distinguishable from the invention now being claimed.

Because Pease is silent regarding any proposed construction or implementation of the weighing device, the most straightforward combination of the teachings of Pease and Westman would be to include the locking spring scale of Westman in the case of Pease. As explained below this would not result in the presently claimed invention.

Westman, as Applicants previously noted, teaches a locking mechanism that must be unlocked to use the weighing device. Applicants specifically note that in col. 2, lines 64-70, Westman describes that the locking member (29) is positionable in one position normally used when the handle “functions just as a plain handle” and another position “only employed where the weight of the luggage requires to be determined.” The non-functionality of the weighing device in normal use is an important feature of Westman and is believed to teach away from the present invention. Westman therefore requires unlocking of a weighing mechanism *and* lifting of a handle to use the weighing mechanism. This is clearly not what Applicants now are claiming.

Independent claim 1 recites, among other recitations, “at least one resistance mechanism having opposing first and second ends, wherein said resistance mechanism is altered by an application of force on said resistance mechanism *whenever the piece of luggage is lifted via the carrying device*”. Independent claim 19 recites, among other recitations, that “said weight is distributed across said means for determining *solely by lifting said means for lifting*.” Independent claim 27 recites, among other recitations, that “the weight determining mechanism comprises a resistance element mechanically subjected to a load bearing weight of the container portion *whenever the luggage container portion is lifted with the lifting element*.” Independent

claim 28 recites, among other recitations” an on-board weight determining mechanism *permanently connected to the lifting element and subject to a load bearing weight of the container portion when lifted via the lifting element.*” Independent claim 29 recites, among other recitations, “an on-board weight determining element *permanently connected across opposing ends of the lifting element, the weight determining element responsive to a load bearing weight of the container portion when lifted via the lifting element* to determine the load bearing weight.

Because neither Pease nor Westman teach at least these recitations of the independent claims, the independent claims are submitted to be patentable over the cited art.

When the recitations of the dependent claims (claims 2-6,9-11, 15, 20-23, 25-26, and 30) are considered in combination with their respective independent claims, the dependent claims are likewise submitted to be patentable over the cited art.

Applicants accordingly request that the rejection of claims 1-6, 9-11, 15, 19-23 and 25-30 under 35 U.S.C. § 103(a) be withdrawn.

B. Pease in view of Westman and Tan

The rejection of claims 7, 8, 11-14 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Pease in view of Westman and further in view of Tan (WO 98/31250) is respectfully traversed.

The combination of Pease, Westman and Tan is not believed to render the presently claimed invention obvious. As noted above, because Pease provides no detail regarding how to implement a weighing device, the most straightforward way to apply the references would be to implement the scale of Westman in the Pease case, or to implement the weight indicator of Tan in the Pease case, neither of which would result in the presently claimed invention.

As for the combination of Westman and Tan, it is noted that the piston and spring disclosed by Tan is considerably different in structure and function from the scale disclosed by Westman such that the two devices are considered to be incompatible, weighing against simple modification of the Westman handle with certain features described by Tan. For example, the

Westman handle 16 is coupled to the bag at its two end points, while the Tan straps 3 couple to the piston at a single point. Reconciling the locking and unlocking features of Westman scale with the strap structure of Tan would appear to be problematic. As another example, the rotating drum 25 of Westman that indicates weight to a user is not clearly applicable to the strap structure of Tan, and the Office Action provides no reason or explanation *why* it would be obvious to mark the rotating drum 25 of Westman with colors or lines. Using lines and colors on the rotating drum of Westman, as opposed to the linear displacement of the Tan piston and the revelation of markings on the piston would not appear to be that desirable. Line and color markings displayed on the rotating drum, as opposed to actual units of weight as disclosed by Westman, would likely be confusing to users such that the drum may not even be recognizable as part of a scale. Even if it was so recognized, a user would be unable to interpret the significance of the displayed line or segment without additional information explaining the lines and colors displayed. This would actual be more difficult to use than either of the Westman or Tan devices as they are described, and it is believed that this combination of features would be generally unacceptable to users of the Pease case.

The rejection appears to be an impermissible hindsight reconstruction of the invention using isolated teachings of various references to deprecate the instant claims. Such hindsight reconstruction of the invention has been repeatedly found to be improper. The Federal Circuit has noted that "to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." *In re Kotzab*, 54 USPQ2d 1308, 1316 (Fed. Cir. 2000). "It is impermissible . . . to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Wesslau*, 147 USPQ 391, 393 (CCPA 1965). See also, *Smithkline Diagnostics, Inc. v. Helena Laboratories, Corp.*, 8 USPQ2d 1468, 1475 (Fed. Cir. 1988) ("claims, entire prior art, and prior art patents must be read 'as a whole'"). If art "teaches away" from a claimed invention, such a teaching supports the nonobviousness of the invention. *U.S. v. Adams*, 148 USPQ 479 (1966); *Gillette Co. v. S.C. Johnson & Son, Inc.*, 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). In light of

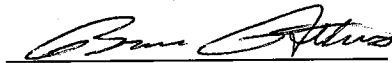
this standard, the combination of Pease in view of Westman and further in view of Tan is not believed to be suggestive of the invention claimed.

It is therefore respectfully submitted, for at least the reasons set forth above, that the presently claimed invention is not obvious over Pease in view of Westman and Tan. Accordingly, Applicants request that the rejection of claims 7, 8, 11-14 and 24 be reconsidered and withdrawn.

3. Conclusion

In view of the foregoing remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



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